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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,867	09/30/2003	Haruhiko Ikeda	N&C-101-02	1356

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EXAMINER

PADMANABHAN, KAVITA

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/673,867	Applicant(s) IKEDA ET AL.	
	Examiner Kavita Padmanabhan	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/941755.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/30/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 10-20 are pending.
2. Claims 10-20 are rejected.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/041,755, filed on 8/30/01.

Claim Objections

4. **Claims 10, 11, and 14-16** are objected to because of the following informalities:

In regards to **claim 10**, the acronym CAD should be spelled out the first time it is recited in the claims, the word "manufactures" should be changed to --manufacturers-- at lines 5 and 18 of the claim, the word --a-- should be added before the word "user" at line 10 of the claim, and the word --the-- should be added before the word "user" at line 14 of the claim.

In regards to **claim 11**, the word "manufactures" should be changed to --manufacturers-- at lines 4 and 17 of the claim, the word --a-- should be added before

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the word "user" at line 9 of the claim, and the word --the-- should be added before the word "user" at line 13 of the claim.

In regards to **claims 14-16**, "to any of Claims" should be changed to "to Claim" at line 1 of the each of the claims.

Appropriate correction is required. Applicant is requested to correct other similar errors found elsewhere in the claims as well.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 13, 14-17, and 19** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation "the update request" in line 8 of the claim. There is insufficient antecedent basis for this limitation in the claim.

In regards to **claims 14-17**, the term "overlappingly stored" in line 3 of each of the claims is unclear.

Claim 19 recites the limitation "said terminal" in 8 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 19 also recites the phrase "when inputted a update ... said user terminal." This phrase is unclear.

The examiner will apply prior art to these claims as best understood, giving the claim language its broadest reasonable interpretation, in light of the above rejections.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. **Claims 10-20** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,816,861. Although the conflicting claims are not identical, they are not patentably distinct from each other because every element of claims 10-20 is anticipated by claims 1-9 of Patent No. 6,816,861. For example, claim 1 of 6,816,861 contains each element of instant claim 10, and therefore fully encompasses/anticipates instant claim 10.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 10, 12, 14, 16, 18, and 20** are rejected under 35 U.S.C. 102(e) as being anticipated by **Shimizu et al.** (US 6,289,254, hereinafter "Shimizu"), cited by applicant.

In regards to **claim 10**, **Shimizu** teaches a CAD information management system comprising:

- a user terminal connected (**Shimizu; Fig. 4, reference character 1300**), via a communication network (**Shimizu; Fig. 4, reference character 1307**), to a plurality of databases which are managed by a plurality of different manufactures (**Shimizu; Fig. 4, reference character 1308**), for receiving and transmitting information to/from said plurality of databases for storing at least one of CAD drawing information and specification information on a specification of a component forming a CAD drawing (**Shimizu; Abstract, Fig. 26**), corresponding to stored-source address information (**Shimizu; Fig. 26, reference symbol**) based on input information which is inputted by user (**Shimizu; Fig. 3; col. 3, lines 51 – col. 4, line 5**),

- wherein when CAD drawing information or specification information of a component forming a CAD drawing, corresponding to stored-destination address information (**Shimizu; Fig. 26, supply number**), is inputted by user as a search condition (**Shimizu; col. 10, lines 22-29**), said user terminal searches for the stored-source address information (**Shimizu; Fig. 26, reference symbol**), corresponding to said stored-destination address information in said a plurality of databases (**Shimizu; Fig. 4, reference character 1308**) which are managed by a plurality of different manufactures, selects information corresponding to the stored-source address information (**Shimizu; Fig. 26, reference symbol**) from any of said plurality of databases based on the search result (**Shimizu; Fig. 10, Fig. 14, Fig. 23; col. 15, lines 27-35**), and outputs the selected information (**Shimizu; Fig. 17, col. 16, lines 4-7**).

In regards to **claim 12**, **Shimizu** teaches a CAD information management system comprising:

- a server connected, via a communication network (**Shimizu; Fig. 4, reference character 1307**), to a plurality of databases (**Shimizu; Fig. 4, reference character 1308; col. 6, lines 36-37**) which are managed by a plurality of different manufactures, for receiving and transmitting information to/from said plurality of databases for storing at least one of CAD drawing information and specification information on a specification of a component forming a CAD drawing (**Shimizu; Abstract, Fig. 26**), corresponding to stored-source address

- information (**Shimizu; Fig. 26, reference symbol**) based on input information which is inputted by user (**Shimizu; Fig. 3; col. 3, lines 51 – col. 4, line 5**); and
- a user terminal (**Shimizu; Fig. 4, reference character 1300**) connected to said server via an information transfer path (**Shimizu; Fig. 4, reference character 1307**), for receiving and transmitting information to/from said server based on input information which is inputted by user (**Shimizu; col. 6, lines 15-24**),
 - wherein when CAD drawing information or specification information of a component forming a CAD drawing, corresponding to stored-destination address information (**Shimizu; Fig. 26, supply number**), is inputted by user as a search condition (**Shimizu; col. 10, lines 22-29**), said user terminal (**Shimizu; Fig. 4, reference character 1300**) requests a search in accordance with said inputted information to said server, and displays the search result of said server (**Shimizu; col. 14, lines 22-35**), said server extracts the stored-destination address information (**Shimizu; Fig. 26, supply number**) corresponding to the information in response to the search request from said user terminal (**Shimizu; col. 11, lines 6-17**), searches for the stored-source address information (**Shimizu; Fig. 26, reference symbol**), corresponding to said extracted stored-destination address information, in said plurality of databases which are managed by a plurality of different manufactures based on the stored-destination address information, selects information corresponding to the stored-source address information from any of said plurality of databases based on the search result (**Shimizu; Fig. 14, Fig. 17, and Fig. 23; col. 15, lines 27-35**), and

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transfers the selected information to said user terminal (**Shimizu; col. 8, lines 15-22**).

In regards to **claim 14**, **Shimizu** teaches a system according to any of Claims 10, wherein at least one of the CAD drawing information and the specification information is overlappingly stored in said plurality of databases (**Shimizu; col. 7, lines 24-31**).

Claim 16 is rejected with the same rationale given for claim 14.

Claim 18 is rejected with the same rationale given for claim 10.

Claim 20 is rejected with the same rationale given for claim 12.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. **Claims 11, 13, 15, 17, and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shimizu in view of Sano** (US 6,377,964), cited by applicant.

In regards to **claim 11**, **Shimizu** teaches a CAD information management system comprising:

- a user terminal connected (**Shimizu; Fig. 4, reference character 1300**), via a communication network (**Shimizu; Fig. 4, reference character 1307**), to a plurality of databases which are managed by a plurality of different manufactures (**Shimizu; Fig. 4, reference character 1308**), for receiving and transmitting information to/from said plurality of databases for storing at least one of CAD drawing information and specification information on a specification of a component forming a CAD drawing (**Shimizu; Abstract, Fig. 26**), corresponding to stored-source address information (**Shimizu; Fig. 26, reference symbol**)

based on input information which is inputted by user (**Shimizu; Fig. 3; col. 3, lines 51 – col. 4, line 5**),

- wherein when CAD drawing information or specification information of a component forming a CAD drawing, corresponding to stored-destination address information (**Shimizu; Fig. 26, supply number**), is inputted by user as a search condition (**Shimizu; col. 10, lines 22-29**), said user terminal searches for the stored-source address information (**Shimizu; Fig. 26, reference symbol**), corresponding to said stored-destination address information in said a plurality of databases (**Shimizu; Fig. 4, reference character 1308**) which are managed by a plurality of different manufactures, selects information corresponding to the stored-source address information (**Shimizu; Fig. 26, reference symbol**) from any of said plurality of databases based on the search result (**Shimizu; Fig. 10, Fig. 14, Fig. 23; col. 15, lines 27-35**), and outputs the selected information, displays the selected information, and also displays information of the selected information (**Shimizu; Fig. 17, col. 16, lines 4-7**).

Shimizu does not expressly teach update information of the selected information.

Sano teaches update history information (**Sano; col. 7, lines 8-27; col. 9, lines 48-63**).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the system of Shimizu including history information, as taught by Sano, thereby providing flexibility to CAD designers by allowing them to look at previous operations and manipulate the design (**Sano; col. 2, lines 16-30**).

In regards to **claim 13**, **Shimizu and Sano** teach a system according to Claim 11, further comprising:

- a information management means for managing at least one of the CAD drawing information and the specification information (**Shimizu; Fig. 23, col. 3, lines 25-33**), connected to said plurality of databases (**Shimizu; Fig. 4, reference character 1308, col. 6, lines 33-37**) which are managed by a plurality of different manufactures,
- said information management means outputs a result determining whether or not the update request from said terminal is accepted to said terminal (**Shimizu; col. 8, lines 16-23; col. 12, lines 31-36**), and
- wherein when receiving the result of determining that the update request is accepted from said information management means, said terminal updates at least one of the CAD drawing information and the specification information in said plurality of databases (**Shimizu; col. 8, lines 20-24**), and adds the update history information on the update to the update information (**Sano; col. 5, lines 47-56; col. 6, lines 33-35**).

In regards to **claim 15**, **Shimizu and Sano** teach a system according to any of Claims 11, wherein at least one of the CAD drawing information and the specification information is overlappingly stored in said plurality of databases (**Shimizu; col. 7, lines 24-31**).

Claim 17 is rejected with the same rationale given for claim 15.

In regards to **claim 19**, **Shimizu** teaches a method according to Claim 18, further comprising the steps of:

- by an information management apparatus which is connected communication network, managing CAD drawing information and said specification information stored by a plurality of databases, and when inputted a update requests from said user terminal, outputting a result of determining whether or not the update request from said terminal is accepted to said user terminal (**Shimizu; col. 8, lines 20-22; col. 15, line 66 – col. 16, line 6**),
- by said user terminal (**Shimizu; Fig. 4, reference character 1300**), when receiving the result of determining that the update request from said information management apparatus is accepted (**Shimizu; col. 12, lines 37-43**), updating at least one of the CAD drawing information and the specification information in said plurality of databases (**Shimizu; col. 8, lines 17-22**).

Shimizu does not expressly teach adding update history information on update to the update information.

Sano teaches history information and adding update history information on update to the update information (**Sano; col. 5, lines 47-56; col. 6, lines 33-35**).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of Shimizu including adding the update

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history information, as taught by Sano, thereby providing flexibility to CAD designers by allowing them to look at previous operations and manipulate the design (**Sano; col. 2, lines 16-30**).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kavita Padmanabhan** whose telephone number is **571-272-8352**. The examiner can normally be reached on Monday-Friday, 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kavita Padmanabhan
Assistant Examiner
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March 10, 2006


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PRIMARY EXAMINER